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No. 17.

Petition for Rehearing.

IN THE

Supreme Court of the United States,

Rec'd & dist. May 26, 1902

No. 17. October Term, 1901.

THE CARNEGIE STEEL COMPANY, LIMITED

v.

THE CAMBRIA IRON COMPANY.

Petition for Rehearing in Behalf of the Cambria Iron Company.

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PHILIP T. DODGE,
FRANCIS T. CHAMBERS.
Of Counsel.

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THE CAMBRIA IRON COMPANY.

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Petition for Rehearing in Behalf of the Cambria Iron Company.

We hereby respectfully petition the Court to rehear the case for the reasons herinafter stated.

In asking this Court to rehear this case, we fully appreciate the immense amount of thought and time which the Justices have already given to it, and the strong conviction of the majority of the Court that the patentee has given to the world an invention of pre-eminent and dominating importance—an invention of such an order as to entitle the patent to the broadest and most liberal construction consistent with the provisions of the statutes under which the patent was granted and the rules laid down by this Court for the interpretation and construction of the statutes.

While the fact that the sustaining of this patent, with the construction put upon it by the Court, will, according to the evident belief of the Court, place in the hands of the, already portentously powerful, combination controlling it, the practical dominance of what is probably, next to agriculture, the most important industry in the country, and while this consideration will not in the least swerve the Court from its duty

to give to the plaintiffs all that legally is theirs, it will, we believe, incline the Court to a further exercise of the marked patience with which it has sought to untangle the complicated issues which have been raised as affecting the validity and construction of this patent, and which we feel, as is, indeed, intimated in the opinion of the Court, have not been presented on the side of the defendant with the clearness to which the Court is entitled.

Again the fact that the thirteen trained judicial minds before whom the question of the construction of this patent has come for decision have been practically equally divided in their conclusions, indicates, we submit, not only that the questions are nice and difficult ones, but also that one opinion or the other must be based on some fundamental misconception of a dominating fact, for it is almost inconceivable that this disagreement could exist in such minds reasoning from even, approximately, the same premises. We believe we have found in the opinion of the Court a misunderstanding as to a most fundamental fact, the correction of which, by the very logic of the Court's opinion, will inevitably lead to a different conclusion.

Another reason which convinces us that it is our duty, not only to our clients, but to the Court, to ask it to again reconsider this case is that we find in the opinion of the Court, rulings on points of law which will inevitably be considered in the lower courts as unsettling, if not, in effect, reversing principles which have heretofore been maintained and enforced by this Court since the patent statutes first came before it for interpretation.

What we conceive to be the fundamental misconception of fact upon which the opinion of the Court is based, is the assumption by the Court to the effect that the process of storing and mixing in the reservoir as carried on by the defendant was one which, in the language of the Jones Patent "provided means (mixed metal) for rendering the product of

steel works uniform in chemical composition." The opinion of the Court makes it manifest that in presenting the defendant's case, counsel were understood to argue that no infringement of the Jones Process could exist unless the mixing of molten metal was to "absolute uniformity of product," (Opinion, page 23) and it is further clearly manifest that the Court decides the case under the impression that the evidence shows that the defendants have mixed their metal in such a way and to such an extent as to produce a material improvement and approximation to uniformity in the chemical character of the product.

If we had based our defense of non-infringement on the claim that the Jones Patent was limited to a mixing treatment which produced absolute uniformity in the product, or if the evidence shows that, as a matter of fact, the defendant has so mixed its metal that the product was, to a material extent, more uniform in chemical composition than the direct metal, as previously used, for instance, in the Bessemer process, the finding of infringement would, we concede, be inevitable and, moreover, the notable sharpness with which the Court has reviewed this assumed position of the defense would be more than justified, for it would be neither consistent with common sense nor with the rulings of this Court in patent cases, to hold that one availing himself of a patented invention to a substantlal and useful extent could escape liability as an infringer merely because he does not work the invention to the full extent of his practical efficiency.

The ground upon which we based our denial of infringement was that the evidence showed that the process employed by the defendant did not in fact give a product either of mixed iron or of steel made from the iron which, to any substantial or material degree, was more uniform in its chemical composition than was the direct metal, previously used, and if, as may well be the case, the evidence introduced in behalf of the defendant fails to properly emphasize this

fact, it is because, as a matter of fact, it was not claimed by the plaintiff that our treatment of the metal did have the result of giving a product which was substantially and materially uniform in chemical composition.

It is true, and this may very naturally have misled the Court, that in the beginning of its case the plaintiff did assert that its own original practice and, by inference, perhaps, that of the defendant, produced substantially uniform metal. Thus Mr. Gayley says of the effect of the mixing (Record, p. 26) "Metal which therefore varied between the widest limits as much in fact as two per cent. was now reduced in its variations to a few tenths of one per cent. and * * * in our average practice would not exceed a variation in silicon of two-tenths of one per cent." If this was true of the process in which the reservoir is kept well filled up, as the plaintiff and defendant do keep it, then undoubtedly we infringed the patent and got as a result of our treatment practically uniform metal.

But the fact as to that use of the reservoir by the plaintiff which is similar to that of the defendants was very different from that stated by Mr. Gayley as to the original use of the "Jones process" and did not justify the claim that our product was in any material and substantial degree uniform in chemical composition, and the plaintiff did not in the later stages of the preparation of its case, or in brief or argument, claim that we materially unified our product. So far from claiming that our product was so unified as to reduce the average variation in silicon *below two-tenths* (.02) of one per cent. the plaintiff's brief admits that the average variation was over eight tenths (.807) every day and that the daily variation ran as high as one and fifty-seven hundredths (1.57) per ceut.

The above admissions of fact are found on page 17 of the plaintiff's brief and coupled with the distinct admissions that so far from these figures indicating substantial uniformity they showed wide variations in chemical composition; to quote, "the

silicon in the total number of charges supplied in a day's run to the converters **varies within wide limits,"** continuing by stating the actual figures noted above which, counsel say, shows a **" wide range "** of ununiformity and demonstrates that this so-called Jones process operates **" not by preventing the occurrence of changes."**

So far are the facts inconsistent with the hypothesis of our infringement by reason of our mixing securing any substantial uniformity of product, that the plaintiff's counsel repudiate even an analogy between our practices, which they call Jones', and a process of mixing to substantial uniformity. See brief, page 80, where they say : **"The process of Jones,** having for its essential principle the making gradual the changes in the metal, so that the converter man may judge of one charge by the preceding one, **has no real analogy to a process requiring metal of a constant composition."**

Unless, therefore, in referring to the product of the defendant's mixing as **" approximately though not perfectly uniform "** (page 9 of Opinion), and continuing, " the original variations having been lost in their mixture with the dominant pool," and in again referring (page 16 of Opinion) to the residue as acting **" to unify the metals charged into the converters,"** the Court means by " approximately uniform " what the plaintiff's counsel characterize as a variation with **" wide limits "** or again a **" wide range,"** we are constrained to believe that it has been misled as to this most vital fact by the confessedly incorrect, or inapplicable, statements contained in the plaintiff's first deposition.

The opinion of the Court with regard to the nature of the patented process and that it was one for a mixing treatment which would produce **an approximation to uniformity** in the chemical composition of the product, if manifested throughout the entire paper and summed up on page 30, where the Court says : " We do not know how the process can be better described than in the specification itself

'to provide means for rendering the product of steel works more uniform in chemical composition,'" and it would seem conclusive that the finding of the Court as to infringement is based on its misunderstanding as to the actual effect of the mixing process which occurs in the defendant's practice.

As having an important, though collateral, bearing upon what we conceive to have been, the fundamental misunderstanding of fact upon which the opinion of the Court is based, we desire to restate, at this point, our position with regard to the relative quantity of the residue, and to restate our concession of the fact that the maintenance in the mixer of any residue which is compatible with carrying on the mixing operation in such a way as to result in a material unification of the chemical elements in the iron, would be clearly within the second claim of the patent. But the proof is to the effect that the practice of keeping the mixer practically full; *i. e.*, of maintaining in it what the Court refers to as, a dominant pool, is inconsistent with the production of uniform or approximately uniform metal, while, on the other hand, the maintenance of a residue of approximately the amount indicated in the drawings of the Jones apparatus, to wit: of one-third, or of any amount less than this, is perfectly consistent with that approximation to product uniformity which the Court has held to be the essence of the Jones Patent. The reason for this is clear and cannot be better explained than it is explained in the testimony of Mr. Carnegie, who, as his testimony shows, had, next to Jones, the best opportunity for understanding the true nature and true mode of operation of the Jones Process. (See Mr. Carnegie's testimony quoted on pages 40 and 41 of the defendant's brief.) Mr. Carnegie thus refers to as **"the soul of the Jones' invention"** (see his answer to *Q.* 15, p. 431), "the dealing with successive small portions of metal which can be **selected** either at the blast furnace or at the mixer." Again, in his answer to $\times Q.$

26, p. 433, he states as "**the great point,**" "that the Jones' invention gives the superintendents the means of controlling this, whether they will or will not send forward metal which may be at that time unsuitable for combining with the product of the other furnaces; and again in his answer to *RDQ.* 71, p. 433, he states as to the Jones mixing that "**it all depends upon whether a mixture takes place of such suitable metal as in combination will produce the standard quality.**" Now, as a matter of fact, the practice of keeping the reservoir mixers well filled up practically excludes the superintendents from availing themselves of the law of averages to maintain, by judicious selections of metal, an approximately standard quality, and that is the reason for the fact admitted by the plaintiff's witnesses and counsel that the mixing which now occurs in the practice of both parties does not result in the production of metal which, with regard to its chemical composition and admixture, is approximately uniform.

If a dominant residue were, in fact, a factor tending toward a uniformity in product, we think it might well be implied in the reading of the patent by one skilled in the art, although nowhere directly suggested; but, on the other hand, the fact being that the dominance of the residue excludes that selection which, as Mr. Carnegie points out, is essential to product uniformity, would make it apparent to those having expert knowledge that a dominant residue was not within the scope of the patent because incompatible with anything approximating to product uniformity.

We believe that with the misconception of the fact to which we have referred removed, the proof as to the prior practice will present itself to the Court in such a way as to produce very different conclusions from those expressed with regard to the prior patents, but appreciate that it would be too much to ask of the Court to consider these matters in detail in connection with the present petition.

Before leaving this subject, and to prevent possible mis-

understanding by the Court as to our position, we will say further that while the admitted facts show that nothing approximating uniformity in chemical composition is or can be, secured by the defendant's practice, not even such an approximation to uniformity as was secured by the old English and Carnegie practices of pouring from two or more ununiform iron ladles into the converter ladle, it is, we think, inferable from the laws of average that the mixed metal would be somewhat less abruptly irregular than the charges drawn directly from the furnaces, this must have been true of all prior mixing processes as well as our present practice, but as the irregularities are still such as the plaintiff admits, and characterizes as within "wide limits" and of "wide range" and as having "no analogy" to produce uniformity we venture to think that the Court did not have these little and ineffective changes in view in referring to the product as "approximately uniform."

Whether we are right or wrong in our belief that the decision of the Court is based on what seems to us to be an error as to a vital fact, we earnestly beg that the Court will reconsider, with such assistance as can be derived from the labor of counsel, the legal propositions embodied in this opinion and bearing on the fundamental law of patents.

The most important of these is that embodied in pages 21 and 22 of the Court's opinion, as follows:

> "* * * The second claim apparently extends to "the art of mixing all molten metals, but the specifica- "tion, taken in connection with the disclaimer, which "designs a process designed to dispense with the use of "cupolas, shows that it was intended to include metal "tapped from blast furnaces and was probably intended "to be limited to that. Whether the claim would be void "if construed to include cupola metal, it is unnecessary "to consider. It clearly includes metal from blast "furnaces, and is not rendered void by the possibility of

"its including cupola metal. The claim of a patent must "always be explained by and read in connection with "the specification, and as this claim clearly includes "metal taken from blast furnaces, the question whether it "includes every molten metal is as much eliminated from "our consideration in this case as if it were sought to "show that the word 'metal' might include other metals "than iron. Were infringement charged in the use of an "apparatus for mixing cupola metal, the question would "be squarely presented whether the claim had been "illegally expanded beyond the specification."

If this is, and is to remain, the law, our presentation of the defendant's case before the Court has been most irrelevant to the real legal issues. But, with the utmost deference, we submit that it has heretofore been universally accepted as law that a patent claim which covers and includes more than the patentee had a right to claim as new, is *ipse facto*, void, and that, totally irrespective of the fact that the patentee might have been entitled to a more limited claim. On this point Mr. Robinson, in his book on patents, says, sec. 513, "Again "every claim must distinguish the art or instrument which it "embraces from every art or instrument already known. A "claim including any matter before patented, or in possession "of the public, is fatally defective," citing a long list of cases, including rulings of this Court, to this point. Mr. Walker, in his book, extracts the first paragraph of his section 186 from the opinions of this Court in Burns *v.* Myer, 100 U. S., 672; Keystone Bridge Co. *v.* Iron Co., 95 U. S., 278; McClain *v.* Ortmayer, 141 U. S., 425, continuing:

"These are the declarations of the Supreme Court relevant "to the proper strictness to be observed in construing pat- "ents, and they apply to primary patents as much as to sec- "ondary patents. Therefore, when a claim clearly covers a "combination of certain elements, it cannot, by construction, "be so altered as to cover more elements so as not to be "invalid, or to cover fewer elements, and thus be rendered

"more likely to be infringed, or to cover other elements in "place of some that may be omitted but which are not "equivalent therefor. So also claim for a process, substan- "tially as described, cannot be construed to cover an inci- "dental process set forth in the description, but merely rec- "ommended there instead of being required or being stated "to be essential to the principal process of the patent." The author citing in his notes numerous decisions of this and the lower courts in support of his text.

We know of no decided case in which it has been heretofore held that a claim including more than that of which the patentee was the inventor could be sustained unless, by the statutory means of reissue or disclaimer, and in appropriate cases for the application of the remedies, it was previously amended to be strictly limited to what was in fact the patentee's invention.

The ruling of this Court to the effect that Jones' second claim might be held, in the case of an infringer using cupola metal, to have been illegally expanded and therefore of course void, but at the same time that in our case, and because we used direct metal the claim should be held, *pro tempore*, valid and infringed, will inevitably be held to put a new and, in effect, revolutionary construction on the statutes, and will utterly unsettle the present methods of legal procedure in patent cases, shifting from the patentees the duty of "particularly pointing out and distinctly claiming" their invention and placing on the public the almost intolerable burden of finding out, not that the thing claimed was old or new, but whether the patentee was in fact a deserving inventor and entitled to a claim which he had not in fact made.

With regard to this question and also as to the scope of the statutory provisions relating to the amendment of patents, we feel that counsel have not given the Court the assistance to which it is entitled. The case presented so many nice and difficult questions of fact, and the necessity for thoroughly

informing the Court thereon seemed to us so paramount, that we were forced for mere lack of time to practically omit from our oral argument any discussion of the law. Moreover, as to the most important point ruled in the Court's opinion, the question was not raised by the plaintiff's brief, and was not considered by us as one open to discussion in this case, and we respectfully urge that the importance of the ruling, not only to the decision in this important case, but to all future patent cases, and to the relations of patentees to the public, is so great as to warrant a rehearing.

With regard to the questions affecting the disclaimer in this case, the very fact that we appreciated that the time allowed us for the argument could not be such as to enable us to properly discuss the legal questions and their bearing upon the Jones Patent, led us to incorporate in our brief a discussion of the subject with, what we now feel to have been, a confusing rather than a helpful amplitude, and believe that we have entirely failed to make our true position clear to the Court and also that, if we had succeeded in conveying to the Court the thought which was in our minds, the ruling as to the effect of the disclaimer would have been different. Moreover, the reasoning of the Court seems to us to place its decision on the questions raised by the disclaimer, upon the broad question of the possible construction to be given to a claim under the statute as laid down in the portion of the opinion which we have above quoted, for it seems to logically follow that if the fact that the claim includes the treatment of cupola metal can in this case be considered as immaterial, then it was also equally immaterial whether the claim did or did not include Bessemerising as a part of the process, and whether it did or did not, as originally drawn, include the use of the mixed metal for casting into pigs or manufacturing into wrought iron, because, if it is within the power and duty of the Court to make the claim fit the invention, irrespective of its scope as originally determined by the patentee and the Commis-

sioner of Patents, the disclaimer filed could certainly be disregarded because unnecessary and ineffective to make any vital change.

From our point of view, the disclaimer filed in this case was for the purpose of converting the second claim, which, in contrast with the first claim, was expressly inserted in the patent for the purpose of covering the mixing process irrespective of the use of the metal, and particularly to cover the specified uses of casting and treatment in a puddling furnace, into a claim which would include and be limited to the use of the metal in the process of Bessemerising, and this operation of the disclaimer was, as we understand it, precisely the same as that of the disclaimer filed in the case of Grant *v.* Walter, 148 U. S., 547, and in that case decided to be ineffective to save the patent.

If, on further consideration, this Court shall see cause to modify its expressed views as to the possible construction of patent claims, it still seems to us that our understanding of the law of disclaimers would prevail with the Court, and we are, therefore, most anxious to discuss this question in its broad relation to the Patent Law.

The undersigned, of counsel for the Cambria Iron Company, (Mr. James I. Kay, who took part in the argument, being absent in Europe), hereby certify that the foregoing petition and the reasons assigned therein are, in our judgment, such as to merit the consideration of the Court; that we believe the questions of fact and of law to be correctly stated, and that this petition is not filed for purposes of delay.

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